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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/645,139

08/21/2003

Mark Albert

062891.1142

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7590

11/19/2009

BAKER BOTTS L.L.P.

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

EXAMINER

ROBINSON BOYCE, AKIBA K

ART UNIT

PAPER NUMBER

3628

NOTIFICATION DATE

DELIVERY MODE

11/19/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* MARK ALBERT, ROBERT M. BATZ, RICHARD L. GRAY,  
LOUIS F. MENDITTO, MICHAEL S. SUTTON, TZU-MING TSANG, and  
PRANAV K. TIWARI

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Application No. 10/645,139  
Technology Center 3600

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Mailed: November 18, 2009

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Before QUITA GOULD, *Supervisory Paralegal Specialist*  
GOULD, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on November 2, 2009. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellants filed an Appeal Brief dated May 21, 2007. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

According to 37 C.F.R. § 41.37(c)(v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 C.F.R. § 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the Specification as corresponding to each claimed function must be set forth with reference to the Specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of Claimed Subject Matter” appearing on pages 7-8 of the Appeal Brief filed May 21, 2007 is deficient because it does not map independent claims 1, 10, 16, and 22 to the Specification. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to Appellants’ failure to provide a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not, be filed.

Rather, a paper providing a Summary of the Claimed Subject Matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

### EXAMINER'S ANSWER, MISSING SIGNATURES

An appeal conference is mandatory in all cases in which an acceptable Appeal Brief has been filed and a determination to move forward on appeal has been made. The participants of the appeal conference should include (1) the Examiner charged with preparation of the Examiner's Answer, (2) a Supervisory Patent Examiner (SPE), and (3) another Examiner, known as a Conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal. On the Examiner's Answer, below the primary Examiner's signature, the word "Conferees:" should be included, followed by the typed or printed names of the other two appeal conference participants. These two appeal conference participants must place their initials next to their name. The answer must also include the signature of a TC Director or designee to indicate that he or she approves any new grounds of rejection, if presented.

A review of the file finds that the Examiner's Answer filed August 18, 2009 is missing either at least one typed/ printed name of the appeal conference participants and/or is missing at least one initial or signature to make the record clear the appeal conference was held in accordance with MPEP § 1207.01. Therefore, correction is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

1) hold the Appeal Brief filed May 21, 2007 defective, as required by  
37 C.F.R. § 41.37(d);

2) notify the Appellants to submit a “paper” which corrects the  
Appeal Brief’s Summary of Claimed Subject Matter under 37 C.F.R.  
§41.37(c)(1)(v);

3) acknowledge and consider any “paper” submitted by Appellants to  
correct the Appeal Brief;

4) to obtain the necessary conferee signatures; and

5) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the  
Board of Patent Appeals and Interferences at 571-272-9797.

QG/Ssc:

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